

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Michael M. FAINZILBER et al.

Serial No. 09/210,952

Examiner: Not Yet Assigned

Filed: 15 December 1998

Group Art Unit: 1643

For: GAMMA-CONOPEPTIDES

**PETITION FOR FILING PATENT APPLICATION
BY THE ASSIGNEE PURSUANT TO 37 CFR § 1.47(b)**

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicant, the University of Utah, of Salt Lake City, Utah, hereby petitions the Commissioner of Patents and Trademarks to accept the filing of the above-identified U.S. patent application by the University of Utah, the party to which the invention disclosed and claimed in the patent application rightfully belongs.

Accompanying this Petition is a Declaration and Power of Attorney that has been signed by one of the ten inventors and by Brent K. Brown, of the Technology Transfer Office of the University of Utah, for the remaining nine inventors. Also accompanying this Petition is a Declaration signed by Brent K. Brown of the Technology Transfer Office of the University of Utah and a Declaration signed by Joel B. Kirschbaum of the Office of Technology Management, University of California, San Francisco.

The Declaration signed by Brent K. Brown provides proof of the pertinent facts concerning the refusal of certain of the inventors to join in the present application for patent,

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and establishes that the University of Utah has a sufficient proprietary interest in this matter to prosecute this application on behalf of and as agent for the inventor, and showing that such action is necessary to preserve the rights of the parties and to prevent irreparable damage. The Declaration signed by Joel B. Kirschbaum also provides proof of the pertinent facts concerning the refusal of certain of the inventors to join in the present application for patent, and establishes that the University of Utah as well as the Regents of the University of California have a sufficient proprietary interest in this matter to prosecute this application on behalf of and as agent for the inventor, and showing that such action is necessary to preserve the rights of the parties and to prevent irreparable damage.

The name and last known address of the inventors refusing to join in this application are as set forth in the Declaration and Power of Attorney.

The University of Utah is entitled to clear title to the invention and to the above-identified patent application, as well as any patent which issues thereon, on the basis of the University of Utah's Patent, Trademark and Copyright Policy 6-4 with respect to co-inventors Olivera, Walker, Watkins, Shetty, Cruz, Imperial and Colledge. As stated in Brown's Declaration and in Kirschbaum's Declaration, it is believed that Fainzilber's and Burlingame's rights are assignable to the Regents of the University of California, and Kits's rights are assignable to Vrije Universiteit. The University of Utah takes the lead in protecting and licensing technology which is co-owned by the University of Utah and other entities, such as the Regents of the University of California and Vrije Universiteit. The University of Utah then reaches an agreement with the other entities concerning sharing arrangements. A copy

of the University's Policy 6-4 is attached to Brown's Declaration. A copy of the University of California's Patent Policy, effective October 1, 1997, is attached to Kirschbaum's Declaration.

With respect to the patent title rights to an invention as between an employer and the employed, the Supreme Court of the United States has held as follows:

If one is employed to devise or perfect an instrument, or a means for accomplishing a prescribed result, he cannot after successfully accomplishing the work for which he was employed, plead title thereto as against his employer. That which he was employed and paid to accomplish become, when accomplished, the property of his employer. Whatever rights as an individual he may have had in and to the inventive powers and that which they are able to accomplish, he has sold in advance to his employer.

Solomons v. United States, 137 U.S. 342, 3465 (1890).

Accordingly, it is clear that employees, such as the inventors who have not yet signed the Declaration and Power of Attorney for the instant patent application, who are paid to develop an invention, fall within the scope of the language written by the Court.

The inventors have not explicitly refused to cooperate in the patent application process, but rather have simply not responded to requests to cooperate. The University of Utah is therefore entitled to submit this application acting on behalf of, and as agent for, the inventors in accordance with the provisions of 37 CFR §1.47(b).

The requisite fee set forth in 37 CFR §1.17(h) accompanies this Petition. Please charge any additional fees or credit any overpayment for the payment of the filing fee to deposit account number 02-2135. An additional copy of this letter is enclosed for that

purpose. This Petition is submitted in triplicate. Favorable consideration is respectfully requested.

Respectfully submitted,

By Stephen A. Saxe
Stephen A. Saxe
Attorney for Applicants
Registration No. 38,609
ROTHWELL, FIGG, ERNST & KURZ, p.c.
Suite 701-E, 555 13th Street, N.W.
Washington, D.C. 20004
Telephone: (202)783-6040

Dated: July 29, 1999

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Respectfully submitted,

By Stephen A. Saxe
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DECLARATION OF BRENT K. BROWN

Hon. Commissioner of Patents
and Trademarks
Washington, DC 20231

Sir:

BRENT K. BROWN, having personal knowledge of the facts set forth herein, hereby deposes and states as follows:

(1) I am employed as Licensing Associate of the Technology Transfer Office of the University of Utah (hereinafter the "University") of 615 Arapccn Drive, Suite 110, Salt Lake City, Utah 84108. I am specifically authorized by Richard K. Koehn, Vice President for Research for the University of Utah to sign on behalf of the University of Utah patent related documents.

(2) The co-inventors of the subject matter disclosed in patent application Serial No. 09/210,952 are Michael FAINZILBER, Karel S. KITS, Alma L. BURLINGAME, Baldomero M. OLIVERA, Craig WALKER, Maren WATKINS, Reshma SHETTY, Lourdes J. CRUZ, Julia IMPERIAL and Clarke COLLEDGE. On information and belief, these individuals were tasked with the research of identifying new conopeptides. Oliver, Walker, Watkins, Shetty, Cruz, Imperial and Colledge are associated with or collaborated with the University of Utah. Fainzilber and Burlingame are associated with the University of California. Kits is associated with Vrije Universiteit.

(3) Each of the foregoing Olivera, Walker, Watkins, Shetty, Cruz, Imperial and Colledge are obligated to assign their rights in the invention to the University of Utah pursuant to its Patent, Trademark and Copyright Policy 6-4 (copy attached hereto). Fainzilber and Burlingame

are obligated to assign their rights in the invention to the University of Utah pursuant to its Patent, Trademark and Copyright Policy 6-4. Fainzilber and Burlingame are obligated to assign their rights to the Regent of the University of California. Kits is obligated to assign his right to Vrije Universiteit.

(4) On or about March 15, 1999, our office received a Declaration and Power of Attorney, Assignments and Small Entity Statements from the University of Utah's patent counsel for this application. On July 26, 1999, Ms. Watkins faxed the formal papers to the inventors from whom she had not received executed documents. On or about July 26, 1999, patent counsel again check with Ms. Watkins about the status of the formal papers. On or about July 28, 1999, Ms. Watkins called co-inventor Maren Watkins office requesting return of the executed Declaration. On July 26, 1999, Ms. Watkins learned that co-inventor Olivera was out of town, and that Kits, Shetty, Cruz and Colledge are out of the country and unavailable.

(5) Acceptance by the U.S. Patent and Trademark Office of the accompanying declaration and power of attorney that has been signed on behalf of, the University of Utah in its ownership interest and, co-inventors Michael Fainzilber, Karel S. Kits, Alma L. Burlingame, Maren Watkins, Lourdes Cruz, Reshma Shetty, Baldomero Olivera, Julita Imperial, Clark Colledge and Craig Walker is respectfully requested. The University has invested considerable amounts of economic, human and material resources in developing the invention that is the subject of the present application. Grant of the petition which accompanies this declaration is necessary in order to preserve and to protect the University's right in the invention and to prevent irreparable economic harm to the University and the other owners that would otherwise occur.

(6) As all of the co-inventors have not responded to requests to execute inventor declarations, there exists no means, other than submission of the accompanying petition, to proceed with this application. Failure to grant the petition would deprive the University of the right to pursue intellectual property law rights that it would otherwise be entitled to pursue, resulting not only in the deprivation of rights to the University, but also in the forfeiture of considerable resources that have been, and continue to be, expended in further developing the invention disclosed in the patent application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 19 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

THE UNIVERSITY OF UTAH

Date July 29, 1999

By Brent Brown
Brent K. Brown

UNIVERSITY OF UTAH

POLICY AND PROCEDURES MANUAL



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Date	May 10, 1993		
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Subject **PATENTS AND INVENTIONS**

I. PURPOSE

To outline the University's policy regarding patents and inventions.

II. REFERENCES

PPM 2-26, Remunerative Consultation and Other Employment Activities

PPM 6-3, University Faculty Profit-Making Corporation

PPM 6-7, Copyright Policy: Ownership

III. POLICY

A. General Policy

As a public institution, the University of Utah is entrusted with the responsibility to facilitate application of scientific and technical research findings for public use and to provide for an equitable disposition of interests among the inventor(s), the University, and where applicable, the sponsor.

B. Patent Assignment Agreements

1. As a condition of the University's provision of employment, services, facilities, equipment or materials to faculty, staff and students, the University acquires and retains title to all inventions, discoveries and improvements made as the result of University employment or research, or created through the use of time, facilities, equipment or materials owned or paid for by or through the University, except when such facilities, equipment or material are available to the general public. Each full-time faculty and staff member is bound through this policy as is each part-time faculty and staff member and student employee or student participating in research (see also III.B.6, below), and any of the foregoing may be asked to execute an assignment of such inventions, discoveries, and improvements to the University and shall do so on request.

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Subject **PATENTS AND INVENTIONS**

2. The signing of a patent agreement is an administrative convenience for dealing with technology ownership rights, but the terms of this policy are controlling and as with other University policies, constitute conditions of employment and participation in research.
3. Where an invention, discovery or improvement is related to research conducted by faculty, staff or students in connection with both University employment or other research activity involving the use of time, facilities, equipment or materials owned or paid for by the University ("University-related activity"), and with non-University activities, such invention, discovery or improvement shall be presumed to result from University-related activity unless the inventor can demonstrate to the vice president for research that the technology in question was developed solely in connection with non-University activity and without the use of confidential information belonging to the University.
4. Each full or part-time faculty and staff member and student employee or student participating in research is expected also to inform promptly the director of the University Technology Transfer Office concerning all inventions, improvements, and discoveries made as a result of University employment, or created through the use of time, facilities, equipment, and/or materials owned or paid for by or through the University or as a result of University employment or participation in research at the University; to cooperate with and assist the director of the University Technology Transfer Office in the handling of such matters; to execute all rightful papers and do necessary and proper acts to assist the University in obtaining, utilizing and enforcing patent protection on such matters, and to abide by and benefit from the patent policy of the University in effect during the inventor's respective associations with the University.
5. The University, in its sole discretion, may release to an inventor, by written instrument

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PATENTS AND INVENTIONS

only, those inventions owned by but not of interest to the University. It is understood if the University does not actively promote or develop the invention over a 3 year period, the inventor's claim to full rights will be honored. Requests for releases should be made to the director of the University Technology Transfer Office.

6. The University claims no right in or to any invention originated by full or part-time faculty and staff members and student employees as a result of private consulting services performed in compliance with University of Utah Policy and Procedure No. 2-26, relative to Remunerative Consultation and Other Employment Activities and not involving substantial use of University facilities (subject to III.B.3). Further, the University claims no right in or to any invention originated by any full or part-time student who is not participating in organized or sponsored research.

C. University Technology Transfer Office

1. Reporting to the vice president for research, the University Technology Transfer Office is responsible for meeting patent regulations associated with research grants and contracts, oversees retaining whenever possible University rights to inventions developed on such programs, and provides information and general assistance to faculty and other University employees and research participants concerning patent development.
2. The Office evaluates and pursues patent protection on those inventions deemed appropriate for commercialization.
3. The director of the University Technology Transfer Office acts as an agent of the University of Utah Research Foundation, and has authority, with the approval of the vice president for research, the Patent Review Committee and the cognizant dean, to award additional funds as available from the

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PATENTS AND INVENTIONS

Technology Transfer Office to inventors as needed to develop additional information to aid patent prosecution. The director serves also as the principal staff for the Patent Review Committee.

D. Patent Review Committee

1. The Patent Review Committee is appointed by the president of the University. The Patent Review Committee acts as an oversight committee to the University Technology Transfer Office. These oversight functions include policy interpretation, dispute resolution and advice on pursuing patent protection of inventions. The committee also recommends changes in University patent policies and is available to the Research Foundation for technical advice.
2. The Patent Review Committee must approve exceptions to standard University patent procedures, royalty distribution and related matters.

E. University of Utah Research Foundation

The University of Utah Research Foundation is the instrument of the University that commercializes inventions through royalty agreements with external organizations for the mutual benefit of the University and full-time or part-time faculty and staff members and student employees or student participants involved. The University assigns to the University of Utah Research Foundation all rights to those patents that should be exploited. Any surplus funds realized by the Foundation from this activity are allocated to fund the research and education programs of the University.

IV. PROCEDURESA. Patent Prosecution and Commercialization

1. The Research Foundation purchases services of the director of the University Technology Transfer Office to prosecute patents, explore commercialization, and negotiate agreements. The Research Foundation shares royalty income with

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inventors in accordance with University practice (see B., below).

2. Surplus funds derived from the patent program by the Research Foundation are allocated by its Board of Trustees to support appropriate University activities. In making such awards, consideration is given to departments or units of the University which are the origin of commercially successful patents.
3. The University/Foundation in its sole discretion may cause applications or patents to be filed upon assigned inventions in any country. The University/Foundation has the sole right to negotiate and enter into or modify licensing and other agreements covering the manufacture, use and/or sale of products and/or processes based on University-owned intellectual property. The University/Foundation will pay all expenses required to obtain and exploit patent protection on such an invention in the best public interest. In those instances where the University/Foundation determines that it does not wish to cover the expenses required to obtain patent protection, the University/Foundation will permit the inventor to pay all such expenses and thereafter to share any royalty or other revenue with the inventor (see IV.B.2).

B. Distribution of Royalty Income

1. Inventors shall receive a share of royalty income or other revenue received by the University of Utah Research Foundation as a result of commercialization of an invention. The inventors' share of income shall be based on a percentage of such income or revenue remaining after reimbursement of the University for all direct costs of patent prosecution or maintenance and all development funds advanced pursuant to section III.C.3 ("net revenue"). The inventors' share (in the aggregate where there is more than one inventor) shall normally be forty percent of the first twenty-thousand dollars (\$20,000) of net revenue, thirty-five percent of the next twenty-

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thousand dollars (\$20,000) of net revenue, and thirty percent of any additional net revenue received by the Research Foundation.

2. When the University permits the inventor to pay expenses to patent and license an invention, the sharing of any royalty or other revenue shall be on the basis of sixty-five percent to the inventor and thirty-five percent to the University after the inventor has been reimbursed for patent expenses.
3. Exceptions to the above procedures shall be approved by the Patent Review Committee.

C. Copyright Commercialization

In selected instances where commercial marketing of University-owned software programs is envisioned, the responsibility for marketing and licensing is assigned to the University of Utah Research Foundation and the University Technology Transfer Office (see Copyright Policy: Ownership, PPM 6-7).

Approved: Academic Senate 5/3/93; Board of Trustees 5/10/93